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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,196	04/21/2000	Stephen G. Perlman	14531.27.2.2	6989
47973	7590	11/07/2005	EXAMINER	
WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			NGUYEN, CHAU T	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,196

Applicant(s)

PERLMAN, STEPHEN G.

Examiner

Chau Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment, received on 08/16/2005, has been entered. Claims 1-19 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. In addition, claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim 1 and 5 contain subject matter "allow the central device to automatically determine whether the signal is scrambled or non-scrambled", which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the specification, pages 8-9,

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Applicant(s) described "an electronic program guide (EPG) indicates which signals are scrambled and which are non-scrambled", which is opposite with the claimed invention in claims 1 and 5 using central device to determine the signal is scrambled or non-scrambled. For purpose of this rejection, "using the electronic program guide data stored at the central device to allow the central device to automatically determine whether the signal is scrambled or non-scrambled" is interpreted as "using the electronic program guide data stored at the central device to determine whether the signal is scrambled or non-scrambled".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtz, Patent No. 5,574,440, in view of Macrae et al. (Macrae), Patent No. 6,745,391.

7. As to claims 1, 5, 6, 8-9, and 11-12, Kurtz discloses in a home entertainment system including a central device coupled to a plurality of electronics devices, wherein the plurality of electronics devices includes a display device and a descrambler, and wherein the central device manages the operation of the plurality of electronics devices, a method for tuning channels that are requested by a user for display on the display device, the method comprising the steps for:

receiving user input at the central device, wherein the user input selects a channel that corresponds to a signal carrying programming, and wherein the signal is received by the entertainment system (Abstract, col. 1, line 11 – col. 2, line 7, col. 3, lines 15-39, and Fig. 1: switching apparatus 10 (the central device) is employed with an entertainment installation having a cable signal passing through a cable convert box (descrambler), and user can use a remote control to select a channel);

determining at the central device whether the signal is scrambled or non-scrambled, wherein both the scrambled and the non-scrambled signals have to be tuned before being displayed (Abstract, col. 2, line 37 – col. 3, line 11, col. 4, line 47 – col. 5, line 21 and Fig. 1: the central device has green and red light emitting diodes (LEDs) which indicate the signal is scrambled (premium) or non-scrambled (non premium), either scrambled or non-scrambled signal must be tuned before being displayed, they have to be tuned either by set top box, television, or any device and therefore signals must be tuned before being displayed is an inherent feature at the central device);

if the signal is determined to be scrambled, performing the steps for:

routing the scrambled signal from the central device to the descrambler (col. 3, line 40 – col. 4, line 12, col. 4, line 47 – col. 6, line 18, and Fig. 1 & Fig. 2: the premium signal is output to a converter box (descrambler)); and using the descrambler to descramble and tune to one or more channels of the scrambled signal for display on the device (col. 3, line 40 – col. 4, line 12, col. 4, line 47 – col. 6, line 18, and Fig. 1 & Fig. 2: the output of a cable converter box suited for a cable ready TV tuning system); and if the signal is determined to be non scrambled, performing the step for:

using an internal tuner at the central device to tune to one or more channels of the non-scrambled signal for display on the display device, and such that the non-scrambled signal can be displayed (col. 3, line 40 – col. 4, line 12, col. 4, line 47 – col. 6, line 18, and Fig. 1 & Fig. 2: where the signal source selected is a non-premium (non-scramble) channel input, the viewer is provided the use of all the various built-in programming (tuner) and television receiver).

However, Kurt does not explicitly disclose using the electronic programming guide data stored at the central device to determine whether the signal is scrambled or non-scrambled. Macrae discloses peripheral devices located within receiving locations (central devices) for receiving data stream, and the data stream includes electronic programming guide (EPG), and software applications located within the peripheral devices determine whether a program is scrambled or unscrambled (col. 1, lines 54-57, col. 3, lines 12-32 and col. 11, lines 10-34). It would have been obvious to one of

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ordinary skill in the art at the time the invention was made to combine the teaching of Macrae and Kurt to include using the electronic programming guide data stored at the central device to determine whether the signal is scrambled or non-scrambled in turn notify the user that such the signal is available or unavailable for selection.

8. As to claims 2, 7 and 14, Kurtz and Macrae (Kurtz-Macrae) disclose after descrambling and tuning the scrambled signal at the descrambler, performing the step for sending the descrambled and tuned signal from the descrambler to the central device (Kurtz, col. 10, line 3 – col. 11, line 5).

9. As to claims 3 and 13, Kurtz-Macrae disclose wherein the descrambler is a cable box (Kurtz, col. 5, lines 53-67).

10. As to claims 4 and 10, Kurtz-Macrae disclose wherein the user input is sent to the entertainment system by a remote control device (Kurt, col. 4, lines 47 – col. 5, line 21).

11. As to claims 15-16, Kurtz-Macrae disclose wherein receiving the signal by the entertainment system comprises receiving the signal at a single input of the central device, such that whether the signal is determined to be scramble or non-scrambled, the signal is received at the single input of the central device (Kurtz, col. 3, line 40 – col. 4, line 12 and col. 5, lines 22-52: an entertainment having a cable signal passing

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through a cable converter box and which provides both premium and non-premium programming, the connector 23 is labeled "TO CABLE" which is the connection for the input signal of the cable).

12. As to claim 17, Kurtz-Macrae disclose an input over which both the scramble and non-scrambled signals are received (Kurtz, col. 3, line 40 – col. 4, line 12).

13. As to claims 18-19, Kurtz-Macrae wherein the routing is automatically performed upon determining from the electronic programming guide data that the signal is scrambled, and wherein the signal is automatically tuned by the internal tuner upon determining with the electronic programming guide that the signal is non-scrambled (Kurtz, col. 3, line 40 – col. 4, line 12, col. 4, line 47 – col. 6, line 18, and Fig. 1 & Fig. 2: the premium signal is output to a converter box (descrambler); Macrae discloses peripheral devices located within receiving locations (central devices) fro receiving data stream, and the data stream includes electronic programming guide (EPG), and software applications located within the peripheral devices determine whether a program is scrambled or unscrambled (col. 1, lines 54-57, col. 3, lines 12-32 and col. 11, lines 10-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Macrae and Kurt to include using the electronic programming guide data stored at the central device to determine whether the signal is scrambled or non-scrambled in turn notify the user that such the signal is available or unavailable for selection).

Response to Arguments

In the remarks, Applicants argue in substance that

(A) "Macrae does not qualify as 35 U.S.C. 102(b) or 102(a) art because it issued well after the filing date of the present patent application."

As to point A, the Examiner's always realized that the present patent application filed on April 21, 2000 has full benefit of priority as an individual application to a parent patent application filed on February 04, 1999. However, Macrae reference filed on April 16, 1999 has priority as an individual application to a provisional application No. 60/082,046, filed on April 16, 1998. Since the Examiner's cited col. 1, lines 54-57, col. 3, lines 12-32 and col. 11, lines 10-34 of Macrae reference in the above rejection, and the cited columns and lines presented in the provisional application No. 60/082,046, filed on April 16, 1998 can be found on page 2, lines 2-4, page 3, line 27 – page 4, line 8, and page 15, lines 1-12, respectively; therefore, the Macrae reference has full benefit of the provisional application No. 60/082,046, filed on April 16, 1998, and thus the Macrae reference does qualify as 35 U.S.C. 102(b) or 102(a) art because it is inherent the filing date of its provisional application filed on April 16, 1998, which is before the filing date of the present patent application filed on 04/21/2000 and its divisional application filed on February 04, 1999.

B) The Macrae reference does not teach or suggest that electronic program guide data is used to determine whether the signal is scrambled or unscrambled.

As to point B, Macrae discloses in col. 1, lines 54-57, col. 3, lines 12-32 and col. 11, lines 10-34 peripheral devices located within receiving locations (central devices) for receiving data stream, and the data stream includes electronic programming guide (EPG), and software applications located within the peripheral devices determine whether a program is scrambled or unscrambled.

C) There is no teaching to combine Macrae and Kurtz references.

As to point C, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kurtz discloses an entertainment installation having a cable signal passing through a cable converter box and which provides both premium (scrambled) and non-premium (non-scrambled) programming. Macrae discloses a television schedule guide (electronic programming guide) including a detector for determining whether a

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previously scrambled program is unscrambled (Abstract and col. 1, lines 54-57, col. 3, lines 12-32 and col. 11, lines 10-34), which relates to cable signal passing through a cable converter box providing both premium (scrambled) and non-premium (non-scrambled) programming of Kurtz (Kurtz, col. 3, line 40 – col. 4, line 12), therefore, Macrae and Kurtz are analogous art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Macrae and Kurtz to include using the electronic programming guide data stored at the central device to determine whether the signal is scrambled or non-scrambled in order to notify the user that such the signal is available or unavailable for selection.

14. Applicant's arguments with respect to claims 1-19 have been considered but are not persuasive. Please see the rejection and response to arguments above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The examiner can normally be reached on 8:30 am – 5:30 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
Patent Examiner
Art Unit 2176

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
10/30/2005